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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,330	01/08/2001	Yueh-O Yu	JCLA6008	6728

7590 10/26/2004

J. C. Patents, Inc.
4 VENTURE
SUITE 250
Irvine, CA 92618

EXAMINER	
VU, TUAN A	

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/756,330	YU, YUEH-O	
	Examiner	Art Unit	
	Tuan A Vu	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 7/28/2004.

As indicated in Applicant's response, claims 1-2, 5-7,12-13, and 27 have been amended.

Claims 1-29 are pending in the office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> Note: 35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

3. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wells et al., USPubN: 2003/0228912.

As per claim 1, Wells discloses a method for updating personalized products (e.g. *customized* - pg. 6, para 0043 – Note: target devices being verified with predetermined signature or identification, address – see para 0036, 0040, 0043 – combined with the inherent ownership of the gaming devices by a person – see *individual casino or similar locations* – is equivalent to product being personalized, i.e. providing specific programs to certain authenticated target devices owned by a person in whose name such target devices are being updated), comprising:

downloading a personalized program code from a storage device (e.g. *server 466* - Fig. 4);

receiving the personalized program code or data code by a transmission medium, and then transmitting the code to a programmable personalized product (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4); and

programming the personalized program code or data code received from said transmission medium into said programmable personalized product for updating the function or data therein (e.g. Figs. 1 – 5; pg. 6, para 0043-0046).

As per claim 2, Wells discloses a storage device being a hard disk, a CD-ROM (Fig. 4).

As per claim 3, Wells discloses personalized program code or data code being provided by a manufacturer (Fig. 4-5; *game manufacturers* - pg. 6, para 0043).

As per claim 4, Wells discloses that the personalized program code being developed and provided by a user (e.g. pg. 6, para 0043; *customer order 472* – Fig. 4; *information file* - Fig. 5; *laptop 128, game controller board* – Fig. 1A; pg. 3, para 0025, 0028 – Note: programming information enabling user to program and control the security of the download and activation of the downloaded reads on code being developed and provided by a user).

As per claim 5, Wells discloses a transmission medium being a personal computer and a hand-held device (e.g. Fig. 4; pg. 2, para 0017).

As per claim 6, Wells discloses transmission through an interface being a serial port interface (e.g. Fig. 4; *port* – pg. 3, para 0030 – Note: communications port from computer to gaming device implicitly discloses a serial/parallel port or USB port).

As per claim 7, Wells discloses a method for updating personalized products, comprising:

downloading a personalized program code from a web site (e.g. *network* – pg. 3, para 0030; *server 466* - Fig. 4 – Note: network central server computer and workstation for distribution of game products implicitly discloses communication between computers and web sites)

receiving the personal program code or data code by a transmission medium, and then transmitting the code to a programmable personalized product (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4); and

programming the personalized code or data code received from said transmission medium into said programmable personalized product for updating the function or data therein (e.g. Figs. 1 – 5; pg. 6, para 0043-0046).

As per claim 8, Wells discloses communication between the server and a transmission medium via a network of wireless or wired transmission system (e.g. *lan line* - pg. 3, para 0030; pg. 7, para 0051).

As per claim 9, Wells discloses a transmission system utilizing one modem (e.g. pg. 3, para 0030; link *324* – Fig. 3).

As per claim 10, refer to rejection of claim 5.

As per claim 11, Wells discloses a wireless link (e.g. pg. 3, para 0030).

As per claim 12, Wells does not explicitly disclose a wireless transmission system consisting of GSM, CDMA, GPRS; but discloses a wireless link and a handheld device (pg. 2,

para 0017; pg. 3, para 0030), hence has implicitly discloses a wireless protocol and standard associated with the use of handheld device.

As per claim 13, Wells discloses transmission of personalized program code or data code to the programmable personalized product through a serial port or a USB port (Fig. 4; *port* – pg. 3, para 0030 – Note: communications port from computer to gaming device implicitly discloses a serial/parallel port or USB port).

As per claims 14-15, see claims 3-4 respectively.

As per claim 16, Wells discloses a device for updating personalized products, comprising:

an input/output end (e.g. Fig. 1A – Note: input to the local controller or laptop, output from the game controller board into features of the game, like video, audio output);

a programmable memory (e.g. *EEPROM* - pg. 3, para 0025), which is programmed with a personalized program code or data code through the input/output end; and

a personalized function circuit (e.g. *gaming terminal* - Fig. 1A) which updates functions and information according to the personalized program code or the data code stored in said programmable memory.

As per claim 17, Wells discloses a transmission medium to receive and transmit the personalized program code or data code (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4).

As per claims 18-19, see claims 3-4, respectively.

As per claims 20 and 21, Wells discloses a control circuit for producing control functions (e.g. *laptop 128, game controller board* – Fig. 1A); and that the control circuit generates voltage and control signal during programming the programmable memory (e.g. pg. 7,

para 0053; pg. 3, para 0025; Fig. 2 – Note: checking communications correctness and using of laptop to control the download security checking/memory programming is equivalent to providing voltage and control signal during programming of gaming device).

As per claim 22, Wells discloses circuit for decoding a personalized program (e.g. Fig. 1B; Fig. 3 – Note: processor in gaming terminal with embedded processor is equivalent to having circuitry to decode instructions of downloaded personalized program)

As per claim 23, Wells discloses control circuit for transmission of personalized data code in the programmable memory (e.g. pg. 3, para 0028; Fig. 1a, 4).

As per claims 24-25, see Wells (Fig. 4, Fig. 1B; Fig. 3)

As per claim 26, Wells discloses personalized product being a gaming terminal.

As per claim 27, see Wells (*EEPROM* - pg. 3, para 0025).

As per claim 28-29, Wells discloses a program code and a data code within the programmable memory (e.g. pg. 6, *software information, installed programs* – pg. 0043; *data which defines* – para 0046 – Note: installed data or programs reads on program and data being part of the programmable EEPROM of terminals).

Response to Arguments

4. Applicant's arguments filed 7/28/2004 have been fully considered but they are not persuasive. Following are the Examiner's reply to the corresponding points raised in the Applicant's remarks.

(A) Applicant has submitted that the Wells' reference is being filed after the invention and that the claimed priority date upon which the rejection is based is not appropriate since the parent Application No. 09,172,786 is not an issued patent or a publication (Appl. Rmrks, pg. 8, middle

para). In response, Applicant is urged to refer to the MPEP section 2136 [2-1] 35 USC § 102(e) and related sections such as 706.02(f) (1) [R-2], II-Examples, examples 1 and 2. Such referring to will clarify the effect of the latest changes to USC § 102(e) statute, one of which being that if U.S. patent or U.S. application publication issued from an application under 35 USC 111(a), and the patent or application does not claim an benefit of an IA, the patent or application publication has a § 102(e) prior art date as of the earliest U.S. effective filing date.

In the case of publication 2003/0228912 by Wells, the earliest effective date is the date it benefits from parent application, which is 10/14/98.

(B) Applicant has submitted that the prior art does not teach 'personalized product' as the invention requires as opposed to a general public product Appl. Rmrks, pg. 8-9). The claim only recites 'personalized product' but fail to specifically define what constitutes the fact of being 'personalized'. A broad and reasonable interpretation has been adopted such that limitation is perceived as a product destined for delivery to a person owning a device or to the device owned by such person, such delivered product being personalized for the owner of the target device recipient. To that effect, the rejection has been directed to point to portions showing in what way the delivered product is perceived as a personalized product. Further, Wells's method is geared toward making resources-efficient update to game terminals, and the inherent ownership of those terminals in gaming establishments by a person entails that the process of delivering the product is according to the specifications or preferences (as in *customized* –see portions in rejection) given by the establishment or proprietor of those gaming, as opposed to the rationale that the gaming devices as disclosed by Wells are merely there to be maintained and updated solely for a general public use, as in a non-lucrative enterprise. The sole fact that the gaming devices belong

to a gaming location signifies that a person with a intention to run business with profits is behind the process of updating so that the devices are operable in a desirable configuration in a most resources-efficient or profitable way, hence according to some customizing as being pointed out in the rejection. The claim (e.g. claim 1) only calls for the steps downloading, receiving transmitting and programming. Nowhere in the claim is there any specific description about how personalized those products are or what 'personalized' consists of. A broad interpretation has been reasonably applied; and Wells is seen as meeting this limitation.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (703)305-7207. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306 (for formal communications intended for entry)

or: (703) 746-8734 (for informal or draft communications, please consult Examiner before using this number)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA. , 22202. 4th Floor(Receptionist).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
October 4, 2004

ANIL KHATRI
PRIMARY EXAMINER